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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/373,589	08/13/1999	NAOSHI SUGIYAMA	Q55419	2742

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EXAMINER

MITCHELL, MONICA J

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/373,589

Applicant(s)

SUGIYAMA ET AL.

Examiner

Monica J. Mitchell

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 and 30 is/are allowed.
- 6) ☒ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 11, line 20, the word "predetermine" should be changed to "predetermined".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 21-23, 25, 27, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Huston (U.S. Patent Number 5,816,165).

Regarding claim 21, Huston discloses a recording material comprising: a printing surface and a back surface (inherently taught that paper has a printing surface and a back surface); and discernment information prerecorded on said printing surface or said back surface readably (column 3, lines 28-31; discernment information can be read as "bar codes").

Regarding claim 22, Huston discloses a recording material wherein said discernment information is a code and includes information of a recording material dealer and/or a recording material distribution channel (column 3, lines 28-31).

Regarding claim 23, Huston discloses a recoding material wherein said discernment information further includes information of a recording material type, a recording material printing format and a recording material size (column 3, lines 28-31).

Regarding claim 25, Huston discloses a recording material wherein said discernment information is constituted by a positioning indicia disposed in a predetermined position (column 3, lines 33-40) and adapted to recording material positioning for printing (column 3, 41-54).

Regarding claim 27, Huston discloses a recording material further comprising: a positioning indicia (read as "mark A") prerecorded thereon and adapted to recording material positioning for printing (column 3, lines 41-54); and an auxiliary indicia (read as "mark B") prerecorded at a predetermined distance from said positioning indicia in a feeding direction of said recording material (column 2, line 65 to column 3, line 23), said predetermined distance constituting said discernment information (column 3, lines 41-54).

Regarding claim 29, Huston discloses a printing surface and a back surface (inherently taught that paper has a printing surface and a back surface); and a positioning indicia prerecorded on said printing surface or said back surface (column 3, lines 28-31; positioning indicia can be read as "bar codes"); a positioning indicia (read as "mark A") prerecorded thereon and adapted to recording material positioning for printing (column 3, lines 41-54); and an auxiliary indicia (read as "mark B") prerecorded at a predetermined distance from said positioning indicia in a feeding direction of said

recording material (column 2, line 65 to column 3, line 23), said predetermined distance constituting said discernment information (column 3, lines 41-54).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huston (U.S. Patent Number 5,816,165) and further in view of Brass et al. (U.S. Patent Number 4,782,221).

Regarding claim 24, Huston fails to disclose a recording material wherein said printing surface has an effective printing region and a peripheral region defined thereabout, and said discernment information is disposed in said peripheral region.

However, Brass discloses a recording material wherein said printing surface has an effective printing region (column 2, lines 58-65) and a peripheral region defined thereabout (column 2, lines 66-68), and said discernment information is disposed in said peripheral region (column 2, lines 66-68; discernment information can be read as "data strip" which can be found in column 1, lines 54-63).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Brass with the teachings of Huston to convey information when scanned by a reader and to control the alignment of an optical scanner used for reading and to control the rate of scanning.

Regarding claim 26, Huston fails to disclose a recording material wherein said discernment information is constituted by at least one of a length, a width, a shape and a pitch of said positioning indicia.

However, Brass discloses a recording material wherein said discernment information is constituted by at least one of a length, a width, a shape and a pitch of said positioning indicia (column 4, lines 44-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Brass with the teachings of Huston to provide bits of information by each of the data lines, which are preferably read in sequence and each of which is made up of a series of areas of predetermined size and of uniform width.

Regarding claim 28, Huston discloses : a printing surface and a back surface (inherently taught that paper has a printing surface and a back surface); and positioning indicia prerecorded on said printing surface or said back surface readably (column 3, lines 28-31; positioning indicia can be read as "bar codes") and adapted to recording material positioning for printing, wherein at least one of a length, width, a shape and a pitch of said positioning indicia constitutes predetermined discernment information.

Huston fails to disclose adapted to recording material positioning for printing, wherein at least one of a length, width, a shape and a pitch of said positioning indicia constitutes predetermined discernment information.

However, Brass discloses a printing surface and a back surface; and positioning indicia prerecorded on said printing surface or said back surface readably and adapted

to recording material positioning for printing, wherein at least one of a length, width, a shape and a pitch of said positioning indicia constitutes predetermined discernment information (column 4, lines 44-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Brass with the teachings of Huston to provide bits of information by each of the data lines, which are preferably read in sequence and each of which is made up of a series of areas of predetermined size and of uniform width.

Allowable Subject Matter

6. Claims 1-20 and 30 are allowed.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Merz et al. (U.S. Patent Number 6,246,776) discloses an image recording media determination system used with an imaging processing device and is operative for determining whether to form an image on a sheet of image recording media that is fed from a media source.


Biegelsen et al. (U.S. Patent Number 6,335,084) discloses a processor communicating with a code reader device and causes the sheet processing apparatus to process the sheet of material based upon the read code.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica J. Mitchell whose telephone number is 703-306-3430. The examiner can normally be reached on Mon.-Fri. from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-3455 for regular communications and 703-746-3455 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

mjm
January 27, 2003


EDWARD COLES
SUPERVISORY PATENT EXAMINER
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